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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,988	12/19/2001	Graeme Milbourne Clark	1473-070	2573
7590 10/21/2003				
Gottlieb Rackman & Reisman 270 Madison Avenue New York, NY 10016-0601				
			EXAMINER DROESCH, KRISTEN L	
			ART UNIT 3762	PAPER NUMBER 5
DATE MAILED: 10/21/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/018,988

Applicant(s)

CLARK ET AL.

Examiner

Kristen L Droesch

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, the language "... nearer to the entry point of the electrode array to the cochlea ..." is vague. It is unclear what location is being compared by the use of the language "nearer". Is it nearer to the entry point of the electrode array to the cochlea than to the outer surface of the temporal bone or other anatomical reference point?

Claim 1 recites the limitations "the cochlea" in line 3; "the patient" in line 4; "the mastoid cavity" in lines 6-7; and "the entry point" in line 7.

Claim 3 recites the limitations "the flexibility" in line 1.

There is insufficient antecedent basis for these limitations in these claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3762

4. Claims 1-3, and 5-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Maniglia (5,906,635).

5. Regarding claim 1, Maniglia shows an implant package (74) including stimulator electronics contained within a protective housing and being operably coupled to an electrode array (76) adapted for insertion into a cochlea (66) of a patient and being further operably coupled to a receiving and/or transmitting coil enclosed within a protective casing (silicone or PTFE coating), the protective housing being dimensioned and shaped to be capable of location within a mastoid cavity of a patient, the coupling between the protective housing and protective casing being contained in a flexible connection (via locking assembly 45 comprising slot 43, screw 62, and a nut). (Col. 5, lines 43-46; Col. 7, lines 48-64; Col. 8, line 64-Col. 9, line 30) (Figs. 7, 9).

With respect to claim 2-3, Maniglia shows the flexible connection facilitates optimal positioning of the coil depending on the anatomy and age of the patient and the flexibility of the flexible connection between the protective housing and the protective casing is such as to allow changes in head shape as the patient grows (Col. 2, lines 54-67)

Regarding claim 5-7, Maniglia shows the implant package is electrically coupled to the electrode array and the receiving and/or transmitting coil and includes one or more flexible arms (55, 72) containing leads which electrically connect the implant electronic to the receiving and/or transmitting coil (Col. 5, lines 31-46).

With respect to claim 8, Maniglia shows the implant package (74) is a receiver/stimulator package.

Allowable Subject Matter

6. Claim 4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The prior art of record fails to teach or suggest an implant package comprising a protective housing and operably connected to a cochlear electrode array and including a flexible connection between the protective housing and protective casing of a transmitting and/or receiving coil that is made of a material having memory.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristen L Droesch whose telephone number is 703-605-1185. The examiner can normally be reached on M-F, 10:00 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angie Sykes can be reached on 703-308-5181. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Kristen Droesch
kld

Kennedy Schaeetzle
KENNEDY SCHAETZLE
PRIMARY EXAMINER
10-14-03